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THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL BUSINESS CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATI, OH 45224			CHAPMAN, GINGER T	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 10/751,362  
Filing Date: January 05, 2004  
Appellant(s): NAIR ET AL.

**MAR 07 2007**  
**GROUP 3700**

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Richard L. Alexander  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 11 October 2006 appealing from the Office action mailed 5 April 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 6,558,499 B1

PARGASS et al

5-2003

WO 00/13632

STAVRULOV

3-2000

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4, 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Pargass et al (US 6,558,499).

**Claim 1:** Pargass et al disclose an absorbent product (10) comprising a package and at least n absorbent articles contained in the package, wherein n is greater than 10 (column 5, lines 3-5), each of the absorbent articles having a body contacting surface (14) and a garment contacting surface (22) opposing the body contacting surface, each of the absorbent articles comprising: a component material (26) disposed between the body contacting surface (14) and the garment contacting surface (22), the component material (26) having a printed graphic (21, 21') which is seen through either the body contacting surface or the garment contacting surface (figs. 1 and 2); wherein the printed graphic (21, 21') of each of the n absorbent articles is different from the graphic of each of the remaining absorbent articles (c. 15, ll. 44-52 and c. 15, ll. 60 to c. 16, ll. 1-2) and all of the printed graphics (21, 21') of the n absorbent articles have a predetermined association (c. 10, ll. 17-21; see also c. 6, ll. 59; c. 7, ll. 12-15; c. 10, ll. 36-37). See also c. 2, ll. 9-13, disclosing that printed graphics having a predetermined association are known in the diaper art.

Further,

Where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. *In re Ngai*, \_\_\_ F.3d \_\_\_, 2004 WL 1068957 (Fed. Cir. May 13, 2004). See also *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally

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related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability .... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.").

See MPEP § 2112.01 III.

**Claim 2:** Pargass et al disclose the predetermined association includes a predetermined order (c. 10, ll. 17-21; see also c. 10, ll. 36-37; c. 7, ll. 12-15; c. 6, l. 59; and the n absorbent articles are stacked in the package in accordance with the predetermined order (c. 15, l. 60-67 to c. 16, ll. 1-2).

**Claim 4:** Pargass et al disclose the predetermined order is an order of usage instruction (c. 6, l. 59; see also c. 6, ll. 55-58).

**Claim 10:** Pargass et al disclose, in Fig. 4a, the component material is selected from the group consisting of a backsheet (22) (col. 8, ll. 47-48).

**Claim 11:** Pargass et al disclose n is selected from 11 to 120 (c. 5, ll. 4-5).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pargass et al in view of Stavrulov (WO 00/13632).

**Claim 4:** Pargass et al disclose, at c. 6, ll. 55-59, that the predetermined orders include, *inter alia*, an order of usage instructions, a sequential indication means and combinations thereof, but does not expressly disclose an order illustrating story, an order for daily activity, an order for educational training, an order illustrating child care tips, and an order of sales promotion. Stavrulov, at page 3, lines 15-22 expresses the desire and clear motivation to increase the attractiveness of diapers with graphics in the form of texts and pictures of educational,

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entertaining, instructive or other nature attractive to a consumer thereby increasing consumer demand for the product. Stavrulov teaches diapers in packages having printed graphics in predetermined associations including, *inter alia*, an order illustrating story, (p. 7, l. 24) an order for daily activity (p. 7, l. 20-23), an order for educational training (p. 7, l. 18), a sequential indication means (p. 7, ll. 19-21), an order of usage instruction (p. 1, l. 20-21), an order illustrating child care tips (p. 7, l. 21), and an order of sales promotion (p. 12, l. 2).

Further, Stavrulov teaches the images do not repeat (p. 8, ll. 9-22). Stavrulov teaches the benefit of each of the printed graphics being different from each other graphic in the package of diapers is that the consumer receives the maximum educational, entertaining and instructional information with each purchase (p. 8, ll. 23-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the variety of graphics having predetermined orders as taught by Stavrulov in the predetermined order of graphics printed on the component material of the diapers of Pargass et al since Stavrulov states at page 11, lines 11-16 that such graphics attract consumer attention and stimulate the purchase of the product by the consumer.

**(10) Response to Argument**

I. Appellants argue that Pargass fails to teach each and every limitation present in the claims because claim 1 includes the limitation of each diaper in the package has a printed graphic different from the printed graphics on the remaining diapers in the package and further recites the limitation of all of the printed graphics of the articles have a predetermined association.

This argument is not persuasive for the following reasons:

First, nonfunctional printed matter does not distinguish a claimed product from an otherwise identical prior art product. Pargass teaches the article structure as claimed. With regard to the printed graphics, printing graphics comprising stories or written instructions on a diaper do not distinguish over a substantially structurally identical diaper having printed graphics wherein the only difference is the content of the graphics themselves. The proper analogy would be to a book. Each diaper is essentially a page of the book; printing text on a page does not change the structure of the page in a novel manner. Nor does arranging the pages in a particular order. If Appellant could not patent the contents, i.e. the text, of a book, Appellant could not patent the contents of the graphics printed on a diaper in a package of diapers.

Arranging the diapers in a particular order does not render the diapers patentable for the following reasons. For one, see above. Second, the prior art of record teaches arranging them in a particular order and teaches more than one predetermined order. Third, all packages of diapers are arranged in a predetermined order – they are arranged in a stack with a top and a bottom and diapers in the middle. Finally, the instant claim 4 illustrates that the order is purely a matter of choice; when there is a list of possible orders it means that the designer can choose any order he wants.

II. Appellant argues the examiner's reliance on the holding of *In re Ngai* is misplaced because in the present application the printed matter, i.e. the graphic, is functionally related to the substrate because the graphic cannot achieve a consumer benefit purpose without the diaper and the diaper does not achieve its "association" benefit without the printed graphic, and therefore there is a functional relation between the product and the printed matter.

This argument is not persuasive for the following two reasons: (1) the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. Pargass et al expressly discloses the substantially identical relationship between the graphic and the substrate (c. 4, ll. 63-65, see also c. 6, ll. 49-59) and therefore Pargass discloses the claimed relation between the product and the printed matter. (2) Appellant is claiming the content of each graphic is different from the content of the other graphics, i.e., a different picture is on each diaper, however; each graphic on each diaper has the same relationship with its substrate as each other graphic, therefore the content of each graphic does not render the relationship of any particular graphic with the substrate new and unobvious.

III. Appellant argues that the predetermined orders of Pargass do not teach all of the claimed limitations because the claimed predetermined orders require that each graphic in the package of diapers is different from the other graphics on the remaining diapers in the package. This argument is not persuasive because Pargass discloses that predetermined orders are known in the diaper art (c. 2, ll. 9-13), and Pargass expressly discloses at least one graphic on each individual diaper is different from other graphics on the diapers in the package (c. 15, ll. 48-51). Pargass further discloses that each package can include any desired number of diapers and can

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include any desired number of different graphics (c. 15, l. 67 to c. 16, l. 1), therefore Pargass anticipates a package of diapers having different graphics on the diapers.

IV. Appellant argues that Pargass discloses a predetermined order wherein the order includes written instructions, but Pargass does not disclose that the written instructions are provided in a predetermined order, and Pargass does not teach that the predetermined order is selected from the group that includes "an order illustrating story, an order for daily activity, an order for educational training, a sequential indication means, an order of usage instruction, an order illustrating child care tips, an order of sales promotion, and combinations thereof."

This argument is not persuasive because the claim language states the predetermined order is selected from the group that includes an order of usage instructions. Pargass teaches an order of usage instructions (c. 6, l. 59), therefore Pargass meets the claim.

V. Appellant argues that the combination Pargass and Stavrulov would result in diapers in wrappers with graphics printed on the wrappers.

This argument is not persuasive because the examiner is not modifying the location of the graphic on the diaper of Pargass; the examiner is citing Stavrulov for teaching the types of contents of graphics disclosed in the prior art. Pargass discloses the graphics are printed on the diaper. Stavrulov states that the benefits of educational, instructional and entertaining content are attractive and informative for the consumer. It would therefore have been obvious to one having ordinary skill in the art at the time the invention was made to provide the graphics printed on the diaper of Pargass with entertaining content as taught by Stavrulov in order to provide a diaper having entertaining graphics to provide an attractive diaper to the consumer.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ginger Chapman



Conferees:

Tatyana Zalukaeva



Angela Sykes